REMARKS

I. Status of the Claims

Claims 1 to 9, 11, and 12, are pending, as shown in the above listing of the claims. Claim 10 has been cancelled. Claims 1 to 7 and 8 have been amended herein, as set forth above. New claims 11 and 12 have been added by this amendment.

The amendments to claims 1 to 7 were made in order to more clearly and distinctly claim the invention to which applicant is entitled, as disclosed in the specification. Claim 8 has been amended to recite a cutting head assembly comprising, *inter alia,* "a tensioned blade formed of a substantially flat strip of material, the tensioned blade having a first end, a second end, a length, a longitudinal axis, a thickness and a width, wherein the width is greater than the thickness," in order to overcome certain prior art rejections, as discussed in greater detail below. The remaining amendments to claim 8 were made to more clearly and distinctly claim the invention to which applicant is entitled. Written description support for the above amendments may be found throughout the specification and original claims. No new matter has been added.

II. Personal Interview

Applicant's undersigned representative thanks Examiner Dexter for the courtesies extended during the personal interview conducted on September 23, 2004.

III. Objections

The Office has objected to claims 1-7 for the formalities discussed on pages 2 to 3 of the outstanding Office Action. Applicant has amended claim 1, as set forth above, to clarify the claim language. Applicant has also deleted the word "further"

from claims 2, 4, 6, and 7, as requested by the Office. Accordingly, Applicant requests that the objections be withdrawn.

IV. Rejections under 35 U.S.C. §§ 102 and 103 over Hecker

The Office has maintained the rejection of claim 8 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,695,761 ("Hecker"), for the reasons set forth at pages 3 to 4 and 6 to 7 of the outstanding Office Action. Applicant thanks the Examiner for the suggested amendment for overcoming the 102(b) rejection over Hecker, set forth at page 7 of the Office Action.

Applicant has amended claim 8 in accordance with the Examiner's suggestion, to recite a cutting head assembly comprising, *inter alia, "*a tensioned blade formed of a substantially flat strip of material, the tensioned blade having a first end, a second end, a length, a longitudinal axis, a thickness and a width, wherein the width is greater than the thickness". Hecker fails to teach the recited tensioned blade formed of a substantially flat strip of material, the tensioned blade having a width greater than its thickness. Since all the limitations of claim 8 are not taught, Hecker fails to anticipate claim 8, and the rejection should be withdrawn.

The Office has newly rejected claim 9 under 35 U.S.C. 103(a) as being unpatentable over Hecker in view of U.S. Patent No. 1,045,988 (Larsen), for the reasons set forth at page 4 of the Office Action.

Claim 9 depends from amended claim 8, and thus includes all the limitations of claim 8. Further, Larsen fails to supply the missing teachings of Hecker, including a tensioned blade formed of a substantially flat strip of material, the tensioned blade having a width greater than its thickness. Rather, Larsen is directed to a butter cutting apparatus which employs a wire cutting element preferably made of piano steel. See Larson, page 1, lines 101-106. Since neither Hecker nor Larson, either alone or in combination, teach or suggest all of the limitations of claim 9, no *prima facie* case of obviousness exists and the rejection should be withdrawn.

V. Rejection under 35 U.S.C. § 103 over Vasile

The Office has rejected claims 1-9 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,554,253 (Vasile), for the reasons set forth at pages 4 to 6 of the outstanding Office Action. Specifically, the Office refers to Figures 5-7 of Vasile, alleging that Vasile discloses a cutting head assembly with almost every structural limitation of the claimed invention.

The Office admits that Vasile lacks the specific cutting member tensioning configuration that includes a first head member, a second head member and a cutting member tensioning device. In an attempt to supply the missing teachings, the Office takes official notice that such cutting member tensioning configurations are old and well known in the art and provide various well known benefits including facilitating tensioning and untensioning of the cutting member to assist in assembling and disassembling the cutting member from the cutting assembly, as well as re-tensioning the cutting member when the cutting member loosens during usage. In support of this position, the Office refers to four U.S. patents, Nos. 1,045,988 (Larson); 1,959,962 (Nelson); 5,343,623 (Cole); and 5,911,808 (Mendenhall). According to the Office, it would have been obvious to one having ordinary skill in the art to provide the missing cutting member tensioning configuration on the cutting assembly of Vasile for benefits well known in the art.

Applicant respectfully traverses the rejection. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In addition, there must be a reasonable expectation of success. See M.P.E.P. § 2143. Further, the Federal Circuit has held that determinations of *prima facie* obviousness must be supported by a finding of "substantial evidence". *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Unless "substantial evidence" found in the record

supports the factual determinations central to the issue of patentability, the rejection is improper and should be withdrawn. *See Zurko*, 258 F.3d at 1386.

Furthermore, it has also been held that there is no motivation to combine references where the proposed modification renders the prior art unsatisfactory for its intended purpose. See M.P.E.P. § 2143.01.

In the present case, the Office has failed to provide the requisite evidence in support of a *prima facie* case of obviousness. Rather, the Office has taken "official notice" that the claimed cutting member tensioning configurations are old and well known in the art, alleging that there would have been motivation to combine, as described above. However, a close reading of the Vasile reference, along with the references recited by the Office in support of the "official notice," reveals that the evidence of record is inconsistent with a finding of motivation or a reasonable expectation of success, and cannot, as suggested by the Office, support a *prima facie* case of obviousness. Specifically, altering the Vasile cutting member to provide the adjustable tensioning means of Larsen, Nelson, Cold and Mendenhall, would have been inconsistent with the teachings of Vasile. As will be discussed below, Vasile teaches that the cutting member should correspond in size to a depression of the base in order to provide desired alignment and support for the cutting member, while the adjustable tensioning means of Larsen, Nelson, Cole and Mendenhall, on the other hand, require adjusting the size of the cutting member to tension the blade, so that the cutting member would not necessarily correspond in size to the depression of the base. In addition, as will be further discussed below, the cutting apparatuses of the Larsen, Nelson, Cole and Mendenhall references are radically different from the cutting member of Vasile, and the tensioning means disclosed by Larsen, Nelson, Cole and Mendenhall do not appear to be readily applicable to the design of the Vasile cutting member.

As illustrated in Figure 1, Vasile is directed to a food preparation apparatus which comprises a raised base having an opening 14 therein designed to receive a

removably positioned processing member, such as the cutting member of Figure 5 or the juicer 110 of Figure 1. See Column 1, lines 35-37 and column 2, lines 7-10. An operating arm is pivotally attached at one end to the base, which carries a pusher means thereon that is aligned with the various processing members. Column 1, lines 37-40. Alignment of the processing members with the pusher means is necessary because the pusher is configured such that projections thereon have entry to the spaces between, for example, the blades of the cutting members. Column 1, lines 41-45 and column 5, lines 54-60.

The necessary alignment and support of the cutting members with the pusher is provided by a depression 16, which includes a ledge 18 surrounding the opening 14. See Column 2, lines 10-12. The depression is designed to fit various processing members, such as the juicer and cutting member, and to provide rapid and convenient interchangability between the processing members. Column 5, lines 1-2. As illustrated in Figures 1 and 6, both the juicer and cutting member are shown to fit snugly in the depression 16, and the cutting member is taught to have a circular outer circumference that corresponds in size to the depression 16. See column 5, lines 65-66 and Figure 6. Thus, the Vasile apparatus is designed to receive various interchangeable processing members of a given size which are specifically taught to fit into a depression of a corresponding size so as to provide the necessary support and alignment of the cutting members during operation of the apparatus. In addition, it is noted that Vasil teaches that it is "most advantageous" for the depression to employ a circular configuration. Column 2, lines 16-20.

Altering the cutting member of Vasile to include the tensioning devices of any of the Larsen, Nelson, Cole and/or Mendenhall references would be inconsistent with the above teachings of Vasile, since the tensioning configurations taught by each of the Larsen, Nelson, Cole and Mendenhall references would require the size of the cutting member to be adjusted in order to tension the blade. For example, see Larsen, Figure 1 and corresponding description at column 2, lines 87 to 108, which

teaches adjusting screws 27 to retract bar 26, thereby apparently expanding the frame to tension the wire; Nelson, Figure 1 and page 1, lines 80-90, which also teaches tension screws 27 to adjust tension bar 26, thereby effectively expanding the size of the cutting device to tension the cutter wires by adjusting the distance of the tension bar from the frame; Cole, Figure 8 and column 3, lines 61 to 67, which teaches turning bolts 60 to cause tension member 56 to move away from stationary member 40, thereby expanding the size of the knife assembly in order to tension the knife blades; and Mendenhall, Figure 2 and column 2, lines 64-66, which teaches tightening tension bolts to urge tensioner 54 away from frame 12, thus also expanding the size of the apparatus.

One of ordinary skill in the are would not be motivated to alter the cutting member of Figure 5 of Vasile to provide for an adjustable frame, similar to those taught by the Larsen, Nelson, Cole and Mendenhall references discussed above, because such a cutting member having an adjustable size would not readily allow the circumference of the cutting member of the Vasile reference to correspond in size to the depression 16 of the Vasile apparatus, as is required by the teachings of Vasile. As discussed above, and clearly illustrated in Figure 6, the circumference of the Vasile cutting member is made to correspond to the size of the depression 16 in the base of the apparatus. Thus, Applicant asserts that redesigning the cutting member of Vasile to be adjustable in size in order to tension the blade would be inconsistent with the teachings of Vasile.

Further, if the cutting member was redesigned to be adjustable so as not to necessarily correspond to the size of the base, it is not apparent from the evidence of record that the depression 16 would provide the adequate support and alignment of the processing member with the pushing means, which is necessary for the projections of the pushing means to have entry between the spaces between the blades of the cutting member, thus rendering the Vasile apparatus unsatisfactory for its intended purpose. As previously stated above, there is no motivation to combine

where the proposed modification renders the prior art unsatisfactory for its intended purpose. See M.P.E.P. § 2143.01. Accordingly, for this reason alone the proposed rejection lacks the requisite motivation necessary to support a *prima facie* case of obviousness, and the rejection should be withdrawn.

In addition, Applicant asserts that the cutting apparatuses disclosed by each of the Larsen, Nelson, Cole and Mendenhall references, which the Office has recited in support of the rejection, are so radically different in design and construction when compared to the cutting member of Vasile that it would have been unlikely that one of ordinary skill in the art would be motivated to apply the teachings of these references to alter the design of the cutting member of Vasile to provide the claimed tensioning device.

For example, the cutting member of Figure 5 of Vasile is shown to have a relatively simple design, having a circular outer configuration comprising a ring with a rim, designed to correspond in size to the depression 16 of the base, which as previously discussed above, most advantageously employs a circular configuration. Column 2, lines 16-20 and column 5, lines 65 to 72. Two blades 138 and 140 are attached to the ring under tension using gripping blocks 133. See column 5, line 73 to column 6, line 7. No requirement for additional or alternative tensioning means for tensioning the blades is taught as being necessary or desirable.

On the other hand, the Larsen, Nelson, Cole and Mendenhall references teach cutting apparatuses having generally square or rectangular frames have relatively complex designs and irregular shapes when compared with the simple circular design of the Vasile cutting member. See, e.g., Larsen, Figure 1; Nelson, Figure 1; Cole, Figure 8; and Mendenhall, Figure 2. It is not apparent from the references, nor has the Office provided any evidence, that the Larsen, Nelson, Cole and Mendenhall tensioning devices would be readily applicable to the circularly shaped design of the cutting member preferred by the Vasile reference.

Even if, for the sake of argument only, the tensioning means of the Larsen, Nelson, Cole and Mendenhall references were somehow applicable to the Vasile cutting member, Applicant asserts that there is simply no suggestion that it would have been desirable to alter the Vasile cutting member to include such a device, given the differences between the Vasile cutting member and the cutting apparatuses of Larsen, Nelson, Cole and Mendenhall. This is especially true given the fact that Vasile provides no suggestion that an additional tensioning means is necessary or desirable. As the Office is well aware, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination. M.P.E.P. § 2143.01. For all of the above reasons, sufficient motivation to support a *prima facie* case of obviousness does not exist, and the rejection should be withdrawn.

For similar reasons as discussed above, there also would have been no reasonable expectation of success for the proposed Vasile rejection. This is because Vasile teaches the depression 16 in the base of the apparatus provides alignment and support for the processing member, and further that the processing member should correspond in size to the depression 16. Thus, if the cutting member of Vasile were redesigned so as not to correspond to the size of the base, there is simply no reasonable expectation of success that the depression 16 of Vasile would provide the adequate support and alignment of the processing member with the pushing means which would be necessary for the projections of the pushing means to have entry between the spaces between the blades of the cutting member. Without a reasonable expectation of success no *prima facie* case of obviousness exists, and the rejection should be withdrawn.

In conclusion, the evidence of record does not provide either motivation or a reasonable expectation of success for altering the cutting member of Vasile to provide a tensioning configuration, as suggested by the Office. As discussed above, altering the Vasile cutting member to provide the adjustable tensioning means of

Larsen, Nelson, Cole and Mendenhall, would have been inconsistent with the teachings of Vasile that the cutting member should correspond in size to the depression 16 of the base. In addition, the cutting apparatuses of the Larsen, Nelson, Cole and Mendenhall references are radically different from the cutting member of Vasile, and the tensioning means disclosed by Larsen, Nelson, Cole and Mendenhall do not appear to be readily applicable to the circular configuration of Vasile.

In light of these facts, Applicant asserts that it would be improper for the Office to maintain the rejection by simply continuing to take "official notice," alleging that it would have been obvious to combine "well known" tensioning configurations with the Vasile reference for reasons which are "well known" in the art. As previously set forth above, determinations of *prima facie* obviousness must be supported by a finding of "substantial evidence" found in the record. No such evidence is found in the present case. Accordingly, if the Office decides to maintain the rejections over Vasile, Applicant respectfully requests that the Office provide a secondary reference which is properly combinable with Vasile, setting forth the necessary motivation to support a *prima facie* case of obviousness. Otherwise, Applicant requests that the rejection be withdrawn for the reasons of record.

CONCLUSION

Applicant respectfully request reconsideration of the above application, and timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional necessary fees to Deposit Account No: 503030.

Respectfully submitted.

HOLLAND & MIDGLEY, LLP

DATED: November 11, 2004

By: _____
Matthew L. Whipple
Reg. No. 47,217